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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/668,065	09/23/2003	Patrick Evan O'Rourke		3011

7590

08/10/2005

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EXAMINER

SMITH, TIMOTHY SCOTT

ART UNIT	PAPER NUMBER
3632	

DATE MAILED: 08/10/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/668,065	Applicant(s) O'ROURKE, PATRICK EVAN	
	Examiner Timothy S. Smith	Art Unit 3632	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
 - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
 - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
 - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 September 2003.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-15 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-15 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 9-23-03 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input checked="" type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input checked="" type="checkbox"/> Other: <u>Pro Se applicant instructions</u> . |

A

DETAILED ACTION

This Office Action represents a non-final first Office Action for the application titled "SHOWER CADDY FASTENER," filed September 23, 2003.

Specification

1. The title is objected to because of the following informalities: all letters in the title should be capitalized. Appropriate correction is required.
2. The disclosure is objected to because of the following informalities: In the brief description of drawings it is suggested that applicant change "plan" to ~~plane~~. On page 4, line 18, applicant states "an opening represented by the shaded area 5 through which the central arch..." Line 18 should be changed to ~~an opening 5 through which the central arch...~~ On page 5, lines 7-8, applicant states "the cylindrical cavity." "The cylindrical cavity," on page 5, lines 7-8 should be changed to ~~the cylindrical cavity 7~~. Appropriate correction is required. On page 5, lines 17 and 18, applicant states "The band 1 wraps around the pipe, depicted by the circular cross-section 8." Lines 17 and 18 should be changed to ~~The band 1 wraps around the pipe 8~~.

Claim Objections

3. Claim 7 is objected to because of the following informality: "The fastener of claim 1," should be changed to ~~The fastener of claim 5~~. Appropriate correction is required.

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4. Claim 9 is objected to because of the following informality: "from the front surface of the said upward protrusion" should be changed to –from the front surface of said upward protrusion–. Appropriate correction is required.
5. Claim 10 is objected to because of the following informality: "The fastener of claim 8," should be changed to –The fastener of claim 9–. Appropriate correction is required.
6. Claim 15 is objected to because of the following informality: "at the said lengthwise opening," should be changed to –at said lengthwise opening–. Appropriate correction is required.

Claim Rejections - 35 USC § 112

7. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

8. Claims 1-15 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The scope of the subject matter embraced by the claims is unclear. In regards to claim 1, applicant defines attachment means and holding means as separate structures. As understood, claims 4 and 5 define the attachment means as comprising an aperture in the front end of said band, and an upward protrusion integrally formed on the rear end of said band. Additionally, in claim 6, applicant defines the holding means as comprising an upward protrusion integrally formed on the rear end of said band. Finally,

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in claim 7, applicant defines the protrusion of the holding means and the protrusion of the attachment means as the same protrusion. In regards to claim 7, the language is confusing when read in light of claim 1 because in claim 1 the applicant defined the attachment means and holding means as separate elements and thereafter defines them as the same element in claim 7. Accordingly, the scope of the claims is unclear. It is suggested that the applicant redraft the claims to redefine the attachment means and holding means. Appropriate correction is required.

Although the scope of the claims is not clear, the examiner will attempt to apply the prior art as best understood.

Claim 1 recites the limitation "the opposite end" in line 4. There is insufficient antecedent basis for this limitation in the claim. Appropriate correction is required.

Claim 4 recites the limitation "the front end." There is insufficient antecedent basis for this limitation in the claim. Appropriate correction is required.

Claims 5 and 6 recite the limitation "the rear end" in line 2. There is insufficient antecedent basis for this limitation in the claim. Appropriate correction is required.

Claim 8 recites the limitation "said upward protrusion" in line 2. There is insufficient antecedent basis for this limitation in the claim. Appropriate correction is required.

Claim 11 recites the limitation "the front edge," and "the surface of said band." There is insufficient antecedent basis for these limitations in the claim. Appropriate correction is required.

Claim 12 recites the limitation "the upper portion" in line 2. There is insufficient antecedent basis for this limitation in the claim. Appropriate correction is required.

Claim 15 recites the limitation "the top wall" in line 1. There is insufficient antecedent basis for this limitation in the claim. Appropriate correction is required.

Claim Rejections - 35 USC § 102

9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

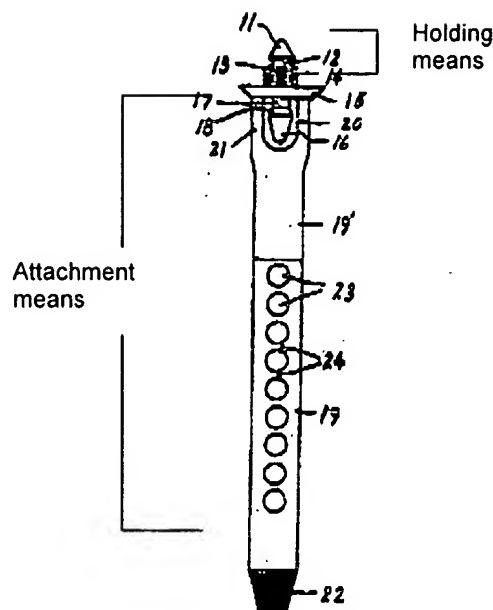
(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

10. Claims 1-11 are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent No. 4,342,428 to Speedie.

Regarding claims 1-11, Speedie discloses a fastener comprising: a band (19 & 19'), said band being formed of a suitable no-slip material that is flexible and elastic (see columns 3 & 4, lines 16-18 and 23-26, respectively), the thickness of said band is shallow relative to the length and width of said band and the length of said band is long relative to the width of said band (see figures 1 & 2 of Speedie); attachment means (see figure below) for connecting one end of said band to the opposite end of said band, said attachment means is further defined as comprising: an aperture (23) in the front end of said band wherein said aperture of said attachment means is sized to fit closely and securely around an upward protrusion (16) of said attachment means (column 3, lines 37-44), said upward protrusion (16) is integrally formed on the rear end of said band;

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and a ledge (18) attached to and protruding perpendicularly from the front surface of said upward protrusion of said attachment means and positioned parallel to and above the top surface of said band at a height which permits the portion of said band that forms the front edge of said aperture to fit between said ledge and the surface of said band below said ledge (columns 2 & 3, lines 60-64 and 30-47, respectively); holding means attached to said band for securely holding a shower caddy on said band, said holding means is further defined as comprising an upward protrusion integrally formed on the rear end of said band (see figure below). Speedie also discloses the elastic properties of said band permit said band to stretch such that said aperture of said attachment means fits over said ledge (column 2, line 68, and column 3, lines 1-7 and 44-47).



Allowable Subject Matter

11. Claims 12-15 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

The following is a statement of reasons for the indication of allowable subject matter:

Regarding claim 12, the prior art failed to teach a holding means that is further defined as comprising a cylindrical cavity extending lengthwise through the upper portion of said protrusion of said holding means.

Conclusion

12. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.


U.S. Pat. Nos. 2,974,916 to Richey, 3,050,578 to Huebner, 3,169,004 to Rapata, 3,269,680 to Bryant, 6,581,885 to Polad disclose a flexible retainer/fastener made of plastic or other suitable material that may be employed to mount and retain articles

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Timothy Smith whose telephone number is 571-272-8296. The examiner can normally be reached on M-F: 8:30AM to 5:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert Olszewski can be reached on 571-272-6788. The fax number for the organization where this application or proceeding is assigned is 703-872-9306.

TSS

Timothy S. Smith
Patent Examiner
Art Unit 3632
August 1, 2005


RAMÓN O. RAMÍREZ
PRIMARY EXAMINER

Attachment to Office Action: Information to Pro Se Inventors Regarding responses to Office Actions

INTRODUCTION

An examination of this application reveals that applicant may be unfamiliar with patent prosecuting procedure. While an inventor may prosecute the application, lack of skill in this field usually acts as a liability in affording the maximum protection for the invention disclosed.

Applicant is advised to secure the services of a registered patent attorney or agent to prosecute the application. The value of a patent is largely dependent upon skillful preparation and prosecution. Although the services of a registered patent attorney or agent is advised, the Office cannot aid in selecting an attorney or agent. 37 C.F.R. § 1.31; M.P.E.P. § 401. However, Applicant is encouraged to peruse the publication entitled "Attorneys and Agents Registered to Practice Before the U.S. Patent and Trademark Office." This publication is for sale by the Superintendent of Documents, U.S. Government Printing Office, Washington, D.C. 20402.

DISCUSSION

The following discussion provides general information for Applicant's benefit regarding an applicant's response, new matter, the period for response, and the certificate of mailing.

I. Response by Applicant

The applicant MUST respond to every ground of rejection and objection made in an Office action. 37 C.F.R. § 1.111. The applicant will generally present arguments that the examiner's rejections or objections were made in error; or amend the specification, drawings,

and/or claims to overcome the rejection or objection. Amendments to the application may not introduce new matter. 37 C.F.R. § 1.118.

Unless the Office explicitly requests the return of a paper, all papers mailed to the applicant are intended to be kept by the applicant for his own records. **The response must be signed by ALL applicants.** 37 C.F.R. § 1.33. The response must be identified by the Serial Number of the Application, the Art Unit, and the name of the examiner. An example follows:

Appl. No. : XX/YYY,YYY
Applicant : James Q. Inventor
Filed: April 19, 2003
Title : Bucket with Handle
Art Unit: 3632
Examiner:: John Doe

A. Arguments

Should the applicant disagree with the examiner's position, the applicant should distinctly and specifically point out the supposed errors in the examiner's action with arguments under the heading "Remarks" in the response. 37 C.F.R. § 1.111. In addition, the applicant must discuss the references cited by the examiner that explain how the claims avoid the references or patentably distinguish from them. *Id.*

B. Amendments to the Specification

An amendment to the specification may remove a rejection or objection. Any amendment to the specification must be presented as a list of additions and deletions, referring to the passages in question by page and line numbers. 37 C.F.R. § 1.121.

An amendment to the specification should appear as follows:

Please replace the paragraph beginning at page 5, line 15, with the following rewritten paragraph:

I -In the construction of the bucket of this invention, various materials have been selected ~~and~~ which offer a number of diverse properties and allow for varied functions of the article. For caustic solutions, the bucket can be made of a durable ~~polymer~~ plastic material. Where an aesthetic appeal is desired, the bucket can be any ~~of~~ one of many attractive colors. The following listing of properties serves to define possible uses for the buckets.—

Please add the following new paragraph after the paragraph ending on line 20 of page 6:

-- An optional feature of the articles of the invention is the addition of a tetrafluoroethylene coating to the bucket to provide protection from any contents which might be caustic. The coating can be provided to the surface during the manufacturing process or can be added in a later step.--

C. Amendments to the Claims

An amendment to the claim may remove a rejection or objection. This listing of claims will replace all prior versions, and listings, of claims in the application:

Listing of Claims:

Claims 1-4 (canceled)

Claim 5 (original): A bucket with a black handle.

Claim 6 (original): A bucket of claim 5 wherein the handle is metal.

Claim 7 (withdrawn)

Claim 8 (currently amended): A bucket made of ~~yellow~~ green plastic.

Claim 9 (previously amended): A bucket made of aluminum-coated galvanized metal.

Claim 10 (previously added): A bucket having a circumferential upper lip.

Claim 11 (new): A plastic bucket having a blue handle.

D. Drawing Corrections

Finally, correction of the drawings may remove a rejection or objection. Changes to the drawings are submitted as proposed drawing corrections and can be made only with permission of the Office. 37 C.F.R. § 1.123. Proposed drawing corrections should be filed with the response, but should be a separate paper. M.P.E.P. § 608.02(r). The proposed corrections should appear in red ink in the drawings. M.P.E.P. § 608.02(v).

II. New Matter

As previously mentioned, no amendment to the specification, claims, or drawings may introduce new matter. 37 C.F.R. § 1.118. "New matter" constitutes any material which meets the following criteria:

- (1) It is added to the disclosure (either the specification, the claims, or the drawings) after the filing date of the application, and
- (2) It contains new information which is neither included nor implied in the original version of the disclosure. This includes the addition of physical properties, new uses, etc.

See M.P.E.P. § 706.03(o). For example, in the amendment to the claim discussed above, the new limitation of "four legs" would not constitute new matter if the specification or drawings originally described the inclusion of four legs on the chair.

III. Period For Response

An Office action generally sets a time period in which the applicant has to respond to every rejection and objection (called a shortened statutory period). 37 C.F.R. § 1.134. This time period for response appears on the cover letter (form PTO-326) of the Office action. Usually, a 3 month shortened statutory period is set. M.P.E.P. § 710.02(b). The applicant's response must be

received within the time period listed on the cover letter, or the application will be held abandoned. 37 C.F.R. § 1.135.

Currently, the Office allows the time period for response to be extended past the shortened statutory period up to a maximum of 6 months (called the maximum 6 month statutory period). In order to extend the period of response past the shortened statutory period, a request for an extension of time and payment of the appropriate fee is required. 37 C.F.R. § 1.136. The request must state that it is for "an extension of the period for response under 37 C.F.R. § 1.136(a)." The following table lists the required fees for extensions of the shortened statutory period:

Months Past Response Date	Fee Due (Small / Large Entity)
Response within Time Allowed	None / None
1	\$60 / \$120
2	\$225 / \$450
3	\$510 / \$1020
4	\$795 / \$1,590
5	\$1,080 / \$2,160

It is important to note that no extension of time is permitted that extends the period for response past the maximum 6 month statutory period. Responses received after the maximum 6 month statutory period will be held abandoned. 37 C.F.R. § 1.135.

Three examples are provided:

Example 1:

A complete response is filed four months and one day after the mailing date of an Office action. The Office action sets a **3 month** shortened statutory period for response. The response

must be accompanied by a fee in the amount of \$205 (for a small entity); \$410 for a large entity) for a 2 month extension of time. The response must also contain a statement requesting "an extension of the period for response under 37 C.F.R. § 1.136(a)."

Example 2:

A complete response is filed five months and one day after the mailing date of an Office action. The Office action sets a **2 month** shortened statutory period for response. The response must be accompanied by a fee in the amount of \$725 (for a small entity); \$1,450 for a large entity) for a 4 month extension of time. The response must also contain a statement requesting "an extension of the period for response under 37 C.F.R. § 1.136(a)."

Example 3:

A complete response is filed six months and one day after the mailing date of an Office action. The Office action sets a **3 month** shortened statutory period for response. The response is held abandoned even if accompanied by a fee and a request for an extension of time. Remember, extensions of time may not be used to extend the period for response past the maximum 6 month statutory period. 37 C.F.R. § 1.135.

IV. Certificate of Mailing

To ensure that the Applicant's response is considered timely filed, it is advisable to include a "Certificate of Mailing" on at least one page of the response. See 37 C.F.R. § 1.8. This

"Certificate" should consist of the following statement:

I hereby certify that this correspondence is being deposited with the United States

Postal Service as first class mail in an envelope addressed to:

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Applicant signature

Date

CONCLUSION AND CAVEAT

The above discussion is not intended to be an exhaustive list of all the topics that may be relevant to this particular Application. The information was provided to familiarize Applicant with the portions of a response that have historically caused problems for *pro se* inventors.

Furthermore, even if Applicant's response is in accordance with the information provided above, there is no guarantee that every requirement of the patent laws (35 U.S.C. §§ 1-376), patent rules (37 C.F.R. §§ 1.1-150.6), and Patent Office policy (M.P.E.P. §§ 101-2591) has been met. The adequacy of a response is determined on a case-by-case basis. *See* 37 C.F.R. § 1.111;

M.P.E.P. § 714.02.